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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,882	08/18/2003	Karin Bergstrom	PST6148US1/2159	3321

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EXAMINER

KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/642,882

Applicant(s)

BERGSTROM ET AL.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 5,9-12 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8,13,14 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Status of Claims***

1. Claims 1-16 are pending.

Claims 1-4, 6-8, 13, 14 and 16 are rejected.

Claims 5, 9-12 and 15 are withdrawn from consideration.

***Election/Restrictions***

2. Applicant's request that claim 5 be examined along with Group I in the reply filed November 16, 2004 is acknowledged. However, although claim 16 will be examined with the elected invention, Group I, claims 1-4, 6-8, 13, and 14, claim 5 will not because it is directed to non-elected subject matter. Although claim 16 contains limitations to the process of claim 5 a product-by-process claim is examined as a product claim because even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art. Thus, since the instant product is the obvious over the product of the prior art the process limitations do not carry any patentable weight. Thus, the Examiner need not search the process of claim 5 in order to reject the product of claim 16.

The previous requirement is still deemed proper and is therefore still made FINAL.

3. Claims 5, 9-12 and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 14, 2004.

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Priority***

5. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Sweden on December 19, 1997. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35

***U.S.C. 119(b). Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4, 6-8, 13, 14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-4, 6-8, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as obvious over Askew et al. (US 4,450,087) or Elliott et al. (US 3,903,006).

Askew et al. suggest an ortho ester having the formula (I). See column 2, lines 12-29.

Askew et al. also suggest ortho esters which are adjacent homologues, i.e., structurally similar, to the ortho ester having the formula (I) (see Table 3). The claimed ortho ester having formula (I) would have been obvious to the skilled artisan because the close structural similarity of the ortho ester of Askew et al. suggests the claimed ortho ester. One skilled in the art would expect the compounds to have similar properties.

Elliott et al. suggest an ortho ester having the formula (I). See column 1, lines 8-33.

Elliott et al. also suggest an ortho ester which is an adjacent, i.e., structurally similar, to the ortho ester having the formula (I) (see Table I). The claimed ortho ester having formula (I) would have been obvious to the skilled artisan because the close structural similarity of the ortho ester of Elliott et al. suggest the claimed ortho ester. One skilled in the art would expect the compounds to have similar properties.

The preambles for claims 6-8, 13 and 14 were not accorded any patentable weight because they are directed merely to intended use. See MPEP 2111.02.

### ***Response to Arguments***

*Rejection of claims 1-4, 6-8, 13 and 14 under 35 U.S.C. 102(b) as anticipated by Askew et al. (US 4,450,087) or Elliott et al. (US 3,903,006)*

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11. Applicant's arguments, see page 7, filed November 16, 2004, with respect to claims 1-4, 6-8, 13 and 14 have been fully considered and are persuasive. The rejection of claims 1-4, 6-8, 13 and 14 has been withdrawn.

Rejection of claims 1-4, 6-8, 13, 14 and 16 under 35 U.S.C. 103(a) as obvious over Askew et al. (US 4,450,087) or Elliott et al. (US 3,903,006)

12. The Applicants' arguments and showing are sufficient to overcome the rejection with respect to the compounds having the claimed formula (I), when  $n_2$  is at least 1. However, when the  $n_2$  is 0 the claims are still considered to be obvious over Askew et al. and Elliott et al. because the showing did not include compounds wherein  $n_2$  was zero. Askew et al. and Elliott et al. also suggest compounds wherein  $n_2$  is zero. Thus, the showing is not commensurate in scope with the protection sought.

For the above reasons, this rejection is maintained.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory

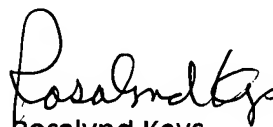
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action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M, R and F 3:00-8:00 pm and T-W 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Rosalynd Keys  
Primary Examiner  
Art Unit 1621

January 21, 2005